

REMARKS

Claim 6 has been amended. Claims 7-8 have been rewritten in independent form. New claims 13-20 have been added. No new matter has been introduced. Claims 1-20 are pending in this application. Please charge any deficiency in the fees to Deposit Account No. 04-1073. A Petition for Extension of Time is being filed concurrently herewith.

Claim 6 stands rejected under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter of invention. The Office Action noted that the claim appeared incomplete and identified a grammatical error.

As suggested by the Examiner, Applicants have amended claim 6 by completing the claim and correcting the grammatical error identified. It is respectfully submitted that claim 6 is in full compliance with § 112, second paragraph.

Claims 1-12 stand rejected under 35 U.S.C. § 101 based on the claimed invention being directed to non-statutory subject matter. The rejection is respectfully traversed. Applicants respectfully submit that each claim is directed to a permissible business method, or machine implemented system or method. State Street Bank & Trust Co. v. Signature Group, Inc., 47 USPQ 2d 1596, 1604 (Fed. Cir. 1998). The Office Action expressed concern that the claims are not "limited to a machine or manufacture which has practical application in the technological arts." Office Action at 3. However, the Board of Patent Appeals and Interferences, in a recent decision, has held there are no "judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101." Ex parte Lundgren, Appeal No. 2003-2088 (2005). In Lundgren, the Examiner rejected a method stating that "without the disclosure or suggestion of computer, automated means, apparatus of any kind, the invention as

claimed is found non-statutory.” Id. The Board disagreed with the rejection and concluded there is no separate “technological arts” test in determining whether a process is statutory subject matter. Therefore, an explicit limitation to a machine or computer should not be necessary in this case.

The Office Action also states that the “steps recited therein are capable of being performed by a person via mental steps or using paper and pencil.” Office Action at 3. This aspect of the Office Action should be reconsidered in light of In re Musgrave, 167 U.S.P.Q. 280 (CCPA 1970). In Musgrave, the claims had been rejected because some, if not all, of the process steps claimed could be also “carried out in or with the aid of the human mind or because it may be necessary for one performing the processes to think.” Id. at 289. Despite this fact, the court found that the claimed process was patentable under § 101. The court rejected the “mental steps” doctrine as a basis for rejecting a claimed process under 35 U.S.C. § 101.

Claims 7-8 stand rejected under MPEP 2106 for having “no clear link or nexus” between the method steps of claim 1 and the program and the computer readable storage medium in dependent claims 7-8. Claim 7 has been rewritten in independent form, as a claim for a “computer program for making a computer execute a magnetic field analysis method for a rotating machine.” Claim 8 has been amended as an independent claim for a “computer program stored on a computer readable storage medium for making a computer execute a magnetic field analysis method for a rotating machine.”

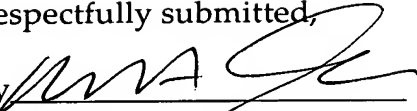
Newly added claims 13-20 depend from claims 1, 7, 9 and 11 and should be allowable along with claims 1, 7, 9 and 11, and for other reasons.

Application No. 10/761,405
Amendment dated
Reply to Office Action of June 6, 2005

Docket No.: A8319.0030/P030

Dated: November 7, 2005

Respectfully submitted,

By 

Mark J. Thronson

Registration No.: 33,082
DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP
2101 L Street NW
Washington, DC 20037-1526
(202) 785-9700
Attorney for Applicant